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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,438	01/30/2001	Theodore R. Coburn	18334-8261002	3483

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09/25/2002

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EXAMINER

NUTTER, NATHAN M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/25/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,438

Applicant(s)

COBURN, THEODORE R.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II, claims 14-20, in Paper No. 5 of 13 September 2002 is acknowledged. The traversal is on the ground(s) that :

- 1) "there is no showing how sequential casting is materially different from the method of claims 1-13",
- 2) "the requisite serious burden on the Examiner set forth in MPEP 803 does not appear to exist", and
- 3) "(n)o basis is given for requiring restriction between inventions I and III".

This is not found persuasive because:

- 1) the Group I claims, drawn to a process for producing a film, can employ resins other than those recited and claimed in Group I. Furthermore, the films of Group II can be made by other known film-producing methods, such as blow-molding techniques, or by coating a substrate with the blend and subsequently removing the coat to produce a film.
- 2) With respect to the requirement between the inventions of Group II and Group III, the burden of an extensive search certainly does exist. The Group II claims are classified in class 525, subclasses 191, 222, 232, 240 and 241, and class 524, subclasses 500, 502, 515 and 523. The inventions of the Group III claims are classified in class 428, subclasses 35.7, 36.91, 36.92, 411.1, 500 and 515, and class 427, subclass 407.1.

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3) The inventions of Groups I and III, as listed, fail to claim the same or corresponding special technical features. The inventions are not disclosed as being capable of use together and possess different characteristics which have different functions and effects, as well as have different modes of operation. The claims of Group I are drawn to a method, but not to a method for producing the inventions of Group III.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The identities of the "structural polymeric material", "clarity-enhancing material", "coloring additive" and "printable material additive" which are critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). These entities are not defined in the Specification so as to understand exactly what is included in the claims. The Specification refers to what is termed examples of each of the "structural polymeric material" and "clarity-enhancing material" but, further, asserts that "other materials...may be used" without specifying what those other materials may embrace. The identity of the "coloring additive", whether it may be a pigment or dye, or whatever it may include is not even discussed by the Specification.

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The practitioner in the art would be required to perform the undue burden of experimentation to determine what may be embraced by these recitations. This is deemed true especially since compatibilities of the resins involved must be established for any blend of polymeric components, since all polymer blends are not compatible.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims fail to adequately teach what may be included as the proper metes and bounds of the claims with regards to the "structural polymeric material", "clarity-enhancing material", "coloring additive" or "printable material additive". Further, the terms "vinyl-acetate (sic)" and "methylemethacrylate" appear to be in polymeric form in the Specification, but of indistinguishable form, e.g. monomer or polymer, in claim 20. The terms "flexibility" and "clarity" in claim 1 are not defined as to what they mean. These characteristics are measurable by known standards in the art, but are left undefined in the instant claims. As such, the instant claims are deemed to be vague and confusing to a practitioner in the art.

Claim Rejections - 35 USC § 102

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Josephy et al, cited by applicant.

The reference to Josephy et al teaches the production of polyethylene or polypropylene blends using an ethylene-vinyl acetate resin. Note column 3 (lines 19-33), column 6 (line 28) to column 7 (line 61) and column 8 (lines 3-39).

Claims 14-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hirata et al, Rosenbaum et al or Nakano et al, each newly cited.

The references to Hirata et al, Rosenbaum et al and Nakano et al all teach the production of polymer blends which may comprise polyethylene or polypropylene with a resin of styrene-ethylene-butylene-styrene (SEB-S), as herein claimed, and, further comprising ethylene-vinyl acetate and coloring additives, as herein claimed.

Note in Hirata et al, column 4 (lines 23 et seq.), column 5 (lines 27-38), the paragraph bridging column 6 to column 7 and the many examples.

Note in Rosenbaum et al, the paragraph bridging column 2 to column 3, column 3 (lines 38-54), the paragraph bridging column 3 to column 4, column 4 (lines 32-41),

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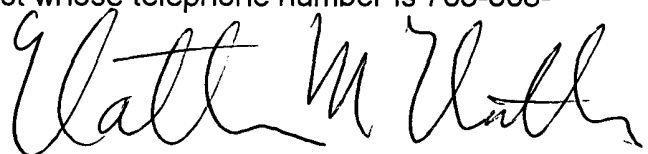
column 5 (lines 37 et seq.), column 6 (lines 8-17 and 48-65) and column 7 (lines 21 et seq.).

Note in Nakano et al, column 2 (line 25) to column 3 (line 45) and column 5 (lines 24-50).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Nathan M. Nutter", written in a cursive style.

Nathan M. Nutter
Primary Examiner
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nmn
September 21, 2002